



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/448,055	11/23/1999	KIMINOBU KODAMA	990612/LH	4616

7590 07/29/2003

FRISHAUF HOLTZ GOODMAN LANGER AND CHICK PC
767 THIRD AVENUE 25TH FLOOR
NEW YORK, NY 10017-2023

EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/448,055

Applicant(s)
Kodama et al

Examiner
Steven McAllister

Art Unit
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 21, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6, 8, and 9 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6, 8, and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2167

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/21/03 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 2-4, 6, 8 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are non-statutory because they are not concrete and tangible since there is no nexus recited in the claims with technology. (It is noted that this is a new rejection being made based on a Board decision. It can be overcome, for instance, simply by reciting a computer in the independent claim.)

Art Unit: 2167

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 2-4, 6, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Costanza (6189980).

Costanza shows defining a series product comprising a family of products (col. 8, ll. 58-62) having a collection of attributes of use or features in a database; defining each product contained in the series product. It inherently shows defining each products by a specific collection values of attributes of use and mapping those values to process steps 15 since the product definition is for defining a product of, for example, a certain diameter, and not simply for defining a product based on what processes are available independent of the desired outcome. It shows deriving a manufacturing process by arranging the process a process 50, and producing the product.

As to claim 2, Costanza shows common specifications since they are all motion transmitting devices (gearboxes).

As to claim 3, Costanza shows an attribute of size.

As to claim 4, Costanza shows having a different size for each product.

As to claim 8, Costanza shows assembly.

Art Unit: 2167

Response to Arguments

6. Applicant's arguments filed 9/16/02 have been fully considered but they are not persuasive.

The applicant argues that the 102 rejection of claim 6 over Costanza is improper because 1) the series products are defined by processes, not attributes of use, and because 2) the step of defining each product of the series product is done by defining products by a collection of processes, not by a collection of attribute values, as claimed.

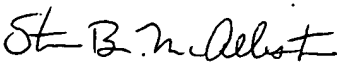
Applicant argues that the 102 rejection of claim 6 over Costanza is improper because the series product is defined by processes, not attributes of use. It is noted that one possible way of defining the family of products (or series product) as disclosed by Costanza is to define them by a common process. However, It more broadly discloses that a family of products are defined by a common feature or attribute, a common manufacturing process being one example (col. 6, 58-62). The reference also shows the series product being defined by an attribute of use, size.

The examiner recognizes that the overall invention of Costanza differs from the disclosed invention in the present case. However, as claimed, the examiner believes that all steps can be found in the reference. In order to speed prosecution, the examiner is open to discussion if the Applicant believes it would be useful.

Art Unit: 2167

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052.


Steven B. McAllister

July 26, 2003^c